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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,821	09/22/2003	Andrew Thurkauf	97,033-U1	1016

7590 06/30/2004  
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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/667,821

**Applicant(s)**

THURKAUF ET AL.

**Examiner**

Emily Bernhardt

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 36-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 36-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Claims 1-12,36-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1.Scope of “alkyl” in alkylthio, mono and dialkylamino in main claims

1,3,44,46,50,56,58 and 62 is not set forth. Note for “alkoxy” a range is set forth.

2.Claims 4-6 are garbled. They are ultimately dependent on claim 3 which doesn't employ R1 but Rx and recites what is not included rather than what is. Also see R1 in claim 8 which isn't in claim 7.

3. The  $K_i$  limitation in all the claims renders intended scope not clear since type of testing can be varied as well as conducted in different environments- in vitro vs in vivo using different animal cells and thus determining what is and what is not within the intended scope is not discernible.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Reitz.

The J.Med. Chem. reference also applied in parent describes a compounds instantly embraced identified as 14 on p.1060. Said compound is employed as an intermediate to making antipsychotic drug 9. Note while said compound is excluded by proviso in main claim 1, no such proviso is seen in claim 3, only 4 dependent thereon.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,7-10,36-45,50-53,56-57,62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad. Prasad discloses compounds for use as

antihypertensives. Closest compound 101 in Table V differs only in being a position isomer, namely having a m-CH<sub>3</sub> vs. instant p-CH<sub>3</sub> on the benzyl ring. Claims 9-10, 52, etc. which embrace an additional methyl on the phenyl ring herein are also deemed obvious since H vs an additional methyl is not deemed a patentable advance absent evidence of superior, unexpected results. See *In re Crounse* 150 USPQ 554; *Ex parte Engelhardt* 208 USPQ 343 regarding position isomerism and *In re Wood* 199 USPQ 137; *In re Lohr* 137 USPQ 548 regarding the addition of a methyl group. Thus it would have been obvious at the time the invention was made to expect instant compounds to possess the utility taught by the applied art in view of the close structural similarity outlined above.

Claims 1-10, 36-53, 56-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morren. Morren discloses similar compounds to that claimed herein for use as neurotropic agents (i.e. agents acting on the central nervous system as herein). See compounds appended to the abstract provided in parent file. While said compounds are higher homologs than the benzyl derivatives claimed herein they have the same type of substitution on the phenyl ring(s) as claimed herein and Morren generically teaches halo and alkyl as viable substituents on the aralkyl ring. Compounds that are homologs are not deemed patentably distinct

absent evidence of superior, unexpected results. Note Ex parte Ruddy 121 USPQ 427; Ex parte Nathan 121 USPQ 349; In re Shetty 195 USPQ 753 regarding the patentability of homologs. Thus it would have been obvious to one skilled in the art at the time the invention was made to expect instant benzyl analogs of Morren=s compounds to be also useful as neurotropics in view of the close structural similarity outlined above.

Claims 1,2,7-10,36-45,50-53,56-57,62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mokrosz . The reference teaches very similar compounds to that claimed herein for use as serotonin antagonists. See compound no.23 in Table I which differs in lacking methyl as instant R1. The same remarks made in the rejection over Prasad regarding H vs. Me apply here as well. Note 4-chlorophenyl in addition to 3-chlorophenyl species claimed would also be expected to share the use of the prior art being also structurally related as a position isomer.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See

In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12, 36-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,859,246,earliest parent of instant case. Although the conflicting claims are not identical, they are not patentably distinct from each other because they embrace overlapping subject matter or are obvious variants as with instant claims differing from claims 7-9 in the US patent as only lacking a methyl on the phenyl ring. See case law cited above in Prasad regarding H vs Me. K<sub>i</sub> limits present in the instant claims are taught as typical for all compounds of the

invention and thus would include most if not all compounds covered by the patent claims.

Claims 1,3-6,36-49,56-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,172,229, greatgrandparent of instant case. Although the conflicting claims are not identical, they are not patentably distinct from each other because they embrace overlapping subject matter or are obvious variants differing only in having H vs Me on phenyl ring . See case law cited in Prasad above. The same remark regarding K<sub>i</sub> limitations in the instant claims apply here as well.

Claims 1-10,36-53,56-65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,426,347, grandparent of instant case. Although the conflicting claims are not identical, they are not patentably distinct from each other because they embrace overlapping subject matter. The same remark regarding K<sub>i</sub> limitations in the instant claims apply here as well.

US'943, most recent parent is only directed to method claims.



References applied above have been provided in earlier parents by applicants or the examiner.

The disclosure is objected to because of the following informalities: Parent history is missing from the specification, p.1. See *Hovlid v. Asari* 34 USPQ 162.

Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is (571) 272-0664.

If attempts to reach the examiner by phone are unsuccessful, the supervisor for AU 1624, Dr. Mukund Shah, can be reached at (571)272-0674.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

  
**EMILY BERNHARDT**

**PRIMARY EXAMINER**

**Group 1600**